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The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE R. DAKIN

Appeal No. 1999-1447
Application 08/446,316

HEARD: March 22, 2000

Before STONER, Chief Administrative Patent Judge, and HAIRSTON
and Nase, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

This is an appeal from the final rejection of claims 43
and 45 through 54.

The disclosed invention relates to a method and apparatus
for reproducing information from a disc. An active squelch
signal is used to prevent output of audio information at
distinct times.

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Claims 45 and 49 are illustrative of the claimed invention, and they read as follows:

45. A disc playing apparatus for reproducing information from a disc storing at least video picture information and audio information corresponding to the video picture information, and receiving a combined video/audio information signal from the disc indicative of both said video picture information and said audio information, said apparatus comprising:

a sequence controlling element, receiving said combined video/audio information signal, and determining at specific times whether the contents of said video/audio information signal are representative of audio or video and producing a first signal indicative of audio being present, said sequence controlling element further producing a second, squelch signal, said squelch signal being in an active state for a time period at least on the order of one-tenth second and transitioning to said active state at least partially at distinct times from transitions of said first signal;

an audio processing circuit, receiving said combined audio/video signal, and receiving said first signal from said sequence controlling element indicative of audio being present, and, when said first signal indicates that audio is present, processing the audio signal to produce an output indicative of the audio signal; and

said audio processing circuit receiving said squelch signal, and preventing output of audio information when said squelch signal is active.

49. A method for reproducing information from an information-containing disc having at least video picture information and audio information corresponding to the video picture information recorded thereon, comprising the steps of:

scanning the disc to produce a combined video/audio information signal from the disc indicative of both video

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picture information and audio;

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determining at specific times, whether contents of said video/audio information signal are representative of audio or video;

producing a first signal indicative of audio being present;

producing a second squelch signal active at least partially, and for a time period at least on the order of one-tenth second, at distinct times from said first signal;

processing said combined audio/video signal in an audio processing circuit responsive to said first signal indicative of audio being present, to produce an output indicative of the audio signal; and

preventing output of audio information when said squelch signal is active.

The references relied on by the examiner are:

Newell	3,789,137	Jan. 29,
1974		
Dakin	4,583,131	Apr. 29,
1986		
	(effective filing date of Aug. 15,	
1979)		
Nakagawa et al. (Nakagawa)	4,809,118	Feb. 28,
1989		
	(filed Apr. 22,	
1986) ¹		

Claims 43 and 45 through 54 stand rejected under 35
U.S.C. § 103(a) as being unpatentable over Newell.

¹Appellant has not challenged the interjection of a Continuation-in-Part (CIP) application in the continuation chain back to July 16, 1979.

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Claims 43 and 45 through 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Newell in view of Nakagawa.

Claims 43 and 45 through 54 stand rejected "under the judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" (Answer, page 3).

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

The rejections of claims 43 and 45 through 54 are reversed.

Turning first to the obviousness rejections, appellant argues (Brief, page 6) that:

Neither Newell nor Nakagawa teach or suggest the claimed squelch signal in the record disc playback apparatus of the type recited in the appealed claims. Newell discloses [Figure 13] a control line connecting code recognition circuit 210 (*sic*) to switch 210 (*sic*) and the rejection of Paper 26 infers that a signal on that line distinguishes audio data from visual data in a signal being recovered from a disc. That signal may be active (*i.e.*, indicate presence of visual data) for a

single frame, which Newell suggests would be for about 33 milliseconds. Assuming for the sake of argument that one of ordinary skill would substitute the Nakagawa data circuits 141-142 [Figure 19] for the Newell switch 210 (*sic*), and also assuming that one of ordinary skill would provide the Nakagawa Gate Signal Generator at the output of the Newell code recognition circuit 210 (*sic*), the result would not be a squelch signal. The result would be a way to divide every third element of a single signal (being recovered from a disc) to either a video refresh memory or an audio expansion circuit. For the sake of argument, the circuit could be modified to be more suitable to the intended function of the switch 210(*sic*), and route an entire video frame to the video refresh memory 212. Such a modification might arguably produce a signal comparable to the claimed first signal, which would indicate (to the switch 210 (*sic*) the presence of audio data in a combined video/audio signal being scanned from the disc. However, such a combination would not produce a signal comparable to the second squelch signal.

We agree with appellant's arguments. Thus, the obviousness rejections of claims 43 and 45 through 54 are reversed because "neither Newell nor Newell in combination with Nakagawa provides a basis for the section 103(a) rejections of the appealed claims, . . ." (Brief, page 23).

Turning next to the double patenting rejection, the examiner's statement of the rejection (Examiner's Answer, pages 3 through 5) is reproduced in toto as follows:

Claims 43 and 45-54 are rejected under the

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judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a disc playing apparatus for reproducing information from a disc storing at least video picture information and audio information having means for scanning the disc to produce the picture information and the audio information and a memory for storing the audio signal outputted from the scanning means. The subject matter recited in claims 43 and 45-54 of this patent application - "comprising ABCY" - is fully disclosed in the patent 4,583,131. The allowance of these claims would extend the rights [sic] to exclude already granted in claims 1-12 of the patent - that right to exclude covering the device "comprising ABCX". The transitional phrase "comprising" does not exclude the presence of elements other than A, B, C, and X in the claims of the patent. Because of the phrase "comprising" the patent claims not only provides [sic] protection to the elements ABCX claimed in the patent but also extends [sic] patent coverage to the disclosed combination - ABCXY. Likewise, if allowed, the claims of this application, because of the phrase comprising, not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY - already disclosed and covered by the claims in the patent. Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in this application.

Furthermore, there is no apparent reason why

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applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).^[2] See also MPEP § 804.

In response to the examiner's Schneller-based rejection, appellant argues (Brief, pages 7 through 17) that Schneller has been overruled by subsequent cases. According to appellant (Brief, page 8), the Court of Customs and Patent Appeals (CCPA) overruled Schneller in In re White, 405 F.2d 904, 906, 160 USPQ 417, 418 (CCPA 1969) by stating "[o]f course, if the appealed invention is unobvious, there can be

²The examiner's rationale for the rejection tracks the reasoning used by the court which is as follows:

While his [Schneller's] invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming BCX and ABCX, but so claiming these combinations as to cover them *no matter what other feature is incorporated in them*, thus covering effectively ABCXY. He now, many years later, seeks more claims directed to ABCX and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse. Schneller, 397 F.2d at 355-56, 158 USPQ at 216.

no double patenting." In White, the CCPA made such statement in connection with nonobviousness under 35 U.S.C. § 103, and not in connection with same invention double patenting under 35 U.S.C. § 101 or the judicially-created, obviousness-type double patenting. The Schneller decision never mentioned "nonobviousness" type double patenting, and the White decision was not addressing the same.³ Thus, the Court had no need to overrule that which it had not created.

³The so-called "nonobviousness" type of double patenting was a creation of the U.S. Patent & Trademark Office. See Manual of Patent Examining Procedure (MPEP) § 804 (6th ed., Jan. 1995), pages 800-15 and 800-16. The latest edition of the MPEP has dropped "nonobviousness" from the description of the Schneller decision.

Appellant argues (Brief, page 8) that the Court sitting en banc in In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 621 (CCPA 1970) overruled prior CCPA decisions, such as Schneller, to the extent that the prior decisions were inconsistent therewith. Schneller was not mentioned in Vogel.

Although the subsequent case of In re Kaplan, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) dealt with an obviousness-type, double patenting rejection, it does not support appellant's arguments (Brief, page 8) because the Court never mentioned Schneller.

Thus, appellant's arguments to the contrary notwithstanding, Schneller did not create a third type⁴ of double patenting rejection (i.e., nonobviousness-type double patenting rejection) (Brief, pages 9 and 10).

Appellant argues (Brief, page 15) that "in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992), the Federal Circuit reiterated that 'same invention' and 'obvious-type' are the

⁴As indicated supra, the judicially-created, obviousness-type double patenting and same invention double patenting under 35 U.S.C. § 101 are the only types of double patenting rejections.

only recognized bases for a double patenting rejection." We agree with appellant's argument. Schneller fits within the latter type of double patenting rejection, and a "*Schneller*-based double patenting [rejection] is legally viable" (Brief, page 11).

Appellant argues (Brief, page 18) that "[i]f *Schneller* was good law, why did the U.S.P.T.O. fail to apply it between 1970 and 1994?" The mere fact that the Office failed to rely on Schneller until it was addressed in the 6th edition of the MPEP does not affect the use of Schneller as a basis for instituting a double patenting rejection when the facts in an application support such a rejection. When Schneller is properly applied, it will not "cast doubt over the validity of an untold number of issued patents, create disputes, and invite litigation" (Brief, page 18).

According to appellant (Brief, page 20), "[t]he second step of the *Schneller*-based double patenting analysis inquires whether there was a reason why an applicant was prevented from presenting the later-examined claims in the prior application." Appellant argues (Brief, page 20) that he "was

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indeed prevented from doing so by operation of Title 37, Code
of Federal Regulation, section

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1.141" which "prevents an applicant from claiming two or more 'independent and distinct' inventions in a single application."

A limitation-by-limitation comparison of the claims on appeal to the claims in the patent is needed to determine whether the two sets of claims present "independent and distinct" inventions. The examiner has not made a "side by side comparison of the reference and application claims." See MPEP § 804 II B(2), page 800-21. Notwithstanding the lack of such an analysis by the examiner, the Court has indicated that appellant should establish that "the invention claimed in his patent is independent and distinct^[5] from the invention of the appealed claims." Schneller, 397 F.2d at 354, 158 USPQ at 214. Accordingly, appellant argues (Brief, page 22) that:

It is clear that the appealed claims and the claims of the '131 patent do not form a single general inventive concept.^[18] The appealed claims recite apparatuses and methods relating to the reproduction of information from a disc. The

⁵In other words, a determination has to be made whether there is a "patentable difference" or a "patentable distinction" between the claims of the patent and the claims on appeal. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278-79, 23 USPQ2d 1839, 1844 (Fed. Cir. 1992).

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subject matter of the appealed claims forms a general inventive concept different from that of the inventions defined by the claims of the '131 patent for the following reasons: Each of the appealed claims recites a device or step for producing and processing a first signal indicative of audio being present and a second, squelch signal which indicates that no audio is present. The general inventive concept defined by the appealed claims allows the signal output from the devices and methods claimed therein to prevent any audio output from being produced while the squelch signal is active. That same general inventive concept is not present in any of the claims of the '131 patent.

Because the appealed claims recite a general inventive concept different from that of the claims of the '131 patent, Applicant was prevented from presenting the appealed playback claims for examination in the application that issued into the '131 patent in 1985-86. Thus, step 2 of the *Schneller*-based double patenting test is not satisfied with respect to the appealed claims, and the rejection of those claims should be withdrawn.

A limitation-by-limitation comparison of the independent claims in the patent to the independent claims in the application is provided infra. To aid in this comparison, the following alphabetical designation has been provided for each signal and element that is claimed in both the patent claims and the application claims:

<u>CLAIMED SIGNAL OR ELEMENT</u>	<u>ALPHABETICAL DESIGNATION</u>
1. Video signal 35	A
2. Audio signal 21	B

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3. Memory 31	C
4. Adaptive Delta Demodulator 23	D
5. Low-Pass Filter 51	E
6. Video Normalizer 55	F
7. Summer 59	G
8. Video/Data Output Signal 61	H
9. Disc Mastering Machine/Disc Reproduction Apparatus	I
10. Video/Data Input Signal 65	J
11. Data Normalizer 67	K
12. Memory 77	L
13. Adaptive Delta Demodulator 99	M
14. Analog Audio Output Signal 101	N
15. Video Output From Disc Reproduction Apparatus	O
16. Chroma Burst Timing Signal 72	P
17. Vertical Blanking Signal 85	Q
18. Horizontal Blanking Signal 87	R
19. Playback Apparatus (Audio/Video)	S
20. Data Flag Signal 73	T
21. Sequence Controller 69	U
22. 7.2 MHZ Enable Signal 75	V
23. Clock Generator 71	W
24. AND gate 83	X
25. Squelch signal 103	Y
26. Record Disc	Z

In the following limitation-by-limitation comparison of independent claims 1, 6, 7 and 12 in the patent to independent claims 45 and 49 in the application, the above-noted alphabetical designations are used for each of the claimed signals or elements. A bold-typed alphabet in the application claims indicates that the signal or element is not in the patent claims:

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U.S. PATENT NO. 4,583,131

Claim 1 - IJLMNOSZ
Claim 6 - IJLMNOPQRSZ
Claim 7 - IJLMNOSZ
Claim 12- IJLMNOPQRSZ

APPLICATION CLAIMS

Claim 45 - IJNUVWYZ
Claim 49 - IJNUVWYZ

From the comparison, it is clearly seen that each of the independent application claims 45 and 49 includes inter alia a first signal indicative of audio being present, and a second signal (i.e., a squelch signal) that is distinct from the first signal, and that is active for a time period at least on the order of one-tenth second. When the squelch signal is active, the application claims prevent the output of audio information. The examiner has not explained how the application claims with this feature could have been presented at the time of prosecution of the patent claims, or how this claimed subject matter is "covered" by the patent claims no matter what other feature is incorporated in them. It would have been equally helpful for an explanation by the examiner as to why no other evidence of obviousness was needed beyond the claims of the patent. In the absence of such a showing or a convincing line of reasoning by the examiner, we agree with the appellant that the added feature(s) in these application

claims "is not present in any of the claims of the '131 patent" (Brief, page 22), and that these claims are "independent and distinct" inventions (Brief, page 20). Stated differently, we agree with the appellant that the inclusion of the squelch signal (i.e., signal Y) in the method and apparatus claims for reproducing information from a disc produced an invention IJNUVWYZ that is patentably distinct from the invention IJLMNOSZ and IJLMNOPQRSZ set forth in the patent based upon the evidence of record. As a result of the patentable distinctness between the application claims and the patent claims, the examiner could have made a restriction requirement in the originally filed application.

DECISION

In summary, the obviousness rejections of claims 43 and 45 through 54 are reversed, and the judicially created doctrine of double patenting rejection of claims 43 and 45 through 54 is reversed.

REVERSED

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BRUCE H. STONER, JR., Chief)	
Administrative Patent Judge)	
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)	BOARD OF
PATENT		
KENNETH W. HAIRSTON)	APPEALS
AND		
Administrative Patent Judge)	
INTERFERENCES		
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KWH:svt

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